

### **REMARKS/ARGUMENTS**

Claims 1-22 are pending in this application, of which claims 1-13 have been withdrawn from consideration. Claim 14 has been amended. Claims 21 and 22 have been canceled. Hence, claims 1-20 remain pending, of which claims 14-20 are under consideration.

Independent claim 14 has been amended to incorporate limitations similar in nature to those of canceled dependent claims 21 and 22. Support for these amendments can be found in the specification and the claims as originally filed. No new matter enters by way of the present amendment. As such, entry of the present amendment is respectfully requested and reconsideration of the subject application as amended is respectfully requested.

#### **I. INTERVIEW SUMMARY**

The Examiner is thanked for the courtesy of the personal interview conducted on June 22, 2005 with Applicants' representative, Darin Gibby. During the interview, the status of pending Claim 14 was discussed, as well as proposed claim amendments. The Examiner indicated that formal consideration of the amendments would be considered upon filing of the present amendment and response. As such, reconsideration is respectfully requested.

#### **II. INFORMATION DISCLOSURE STATEMENT**

The Examiner is thanked for the signed and initialed copies of the PTO-1449 forms received with the Office Action mailed May 12, 2005. However, it is noted that the form PTO-1449 submitted on November 8, 2004 (received by the Office on November 10, 2004, as indicated by the OIPE date stamp) does not include any Examiner initials indicating that the listed U.S. patent documents have been considered and made of record in the present case.

Applicants respectfully request that the Examiner expressly consider the U.S. patent documents listed on the form PTO-1449 submitted on November 8, 2004, and forwarded an initialed copy of the PTO-1449 with the next office communication (or indicate a reason for non-consideration).

### **III. CLAIM REJECTIONS UNDER 35 U.S.C. § 102**

#### **A. Rejection Over Aguerre**

Claims 14-17 and 19-21 stand rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by U.S. Patent No. 6,237,250 to Aguerre, *et al.* ("Aguerre"). This rejection is traversed, and withdrawal of this rejection is respectfully requested for at least the reasons which follow.

The present claims are directed to footwear comprising a sole, an upper portion including a rear opening for receiving a user's foot, and a strap configured to be positioned across the rear opening to engage the back of the user's foot, wherein the strap is attached to the upper portion such that the strap contacts the upper portion and pivots relative to the upper portion. The sole and the upper portion are formed as a first part molded from a first continuous piece of lofted foam material. The footwear further comprises a connector and an adjustment mechanism that is interactable with the connector and the strap to adjust the position of the strap relative to the back of the user's foot.

In contrast, Aguerre discloses a sandal having an active, self-adjusting harness, which, in combination with a center toe strap and an independent adjustable heel strap, functions to retain an insole layer of the sandal to a human foot. Col. 4, lines 10-17. The sandal includes an insole layer, a midsole layer, an outsole layer, a plurality of straps comprising the self-adjusting harness, a center toe strap, and an adjustable heel strap. The three sole layers are vertically stacked and bonded together with a suitable bonding agent. Col. 4, lines 19-32. The center toe strap, a rear strap for securing rear buckles, and the self-adjusting harness are anchored between the insole layer and the outsole layer. Col. 4, line 63 - Col. 5, line 6. The adjustable heel strap is then secured to the insole *via* the rear buckles. Col. 6, lines 25-44.

It is well established that to anticipate a claim, a reference must disclose every element of the claim. *Verdegaal Bros. v. Union Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913 (Fed. Cir. 1989).

Applicants respectfully submit that the sandal disclosed in Aguerre does not include all of the limitations of independent claim 14. For example, at a minimum, the sandal disclosed in Aguerre does not include a sole and an upper portion formed as a first part molded from a first continuous piece of lofted foam material. Even assuming, *arguendo*, that the self-adjusting harness of Aguerre amounts to an upper portion adapted to cover the top of a user's foot, the strap sections of the harness are independent from the stacked sole layers, and thus are not formed as a part molded from a continuous piece of lofted foam material. Furthermore, the "sole" of Aguerre is comprised of three distinct layers (*i.e.*, the insole, midsole, and outsole), and thus is not formed as a part molded from a continuous piece of lofted foam material. As disclosed, the layers of the stacked sole must be discrete layers to allow for the configuration wherein the self-adjusting harness, the center-toe strap, and the rear strap are anchored between the insole layer and the outsole layer. In addition, the adjustable heel strap of Aguerre is not attached to the "upper portion" of Aguerre (*i.e.*, the straps adapted to cross over the top of the user's foot). Rather, the adjustable heel strap is connected to the rear buckles of the rear strap. Moreover, the adjustable heel strap is not connected to the rear buckles so as to pivot relative to the straps of the adjustable harness.

The absence of even a single claim limitation in a prior art reference defeats anticipation. Here, Aguerre fails to disclose *multiple* limitations of independent claim 14. For at least this reason, it is respectfully submitted that Aguerre does not anticipate independent claim 14, and thus claims 15-20 depending therefrom. Reconsideration and withdrawal of this rejection is respectfully requested.

B. Rejection over Girard

Claims 14-17 and 19-21 stand rejected under 35 U.S.C. § 102(e), as allegedly being anticipated by U.S. Patent No. 6,860,035 to Girard ("Girard"). This rejection is traversed, and withdrawal of this rejection is respectfully requested for at least the reasons which follow.

Girard discloses, in part, a sandal including a sole and a tightening device comprising a lower flap and an upper flap which holds the foot in place on the sole. Col. 3, lines 8-13. The lower flap and upper flap together form the upper of the sandal and are fixed on the

sole *via* fixing means located at the lower end of the respective flaps. Col. 3, lines 28-29. The tightening device also includes a tightening mechanism comprising at least one anchor positioned on each of the flaps which makes it possible to bring the flaps closer together so as to encircle the foot against the sole while properly distributing the pressures generated by the tightening device. Col. 2, lines 16-21; Col. 3, lines 42-46. The pressures are further distributed, in part, by the fact that the upper flap is more flexible than the lower flap. Col. 4, lines 21-24. The tightening device also includes an optional rear holding component comprising a strap that is fixed to one of the flaps, passes through a guide fixed on the other flap, and includes a fixing mechanism. Col. 3, lines 18-23.

As discussed above, the absence of even a single claim limitation in a prior art reference defeats anticipation. In this regard, Applicants respectfully submit that the sandal disclosed in Girard does not include all of the limitations of independent claim 14. For example, at a minimum, the sandal disclosed in Girard does not include a sole and an upper portion formed as a first part molded from a first continuous piece of lofted foam material. The flaps of the upper as disclosed by Girard are discrete elements and are independent from the sole of the sandal. In addition, the rear holding strap of Girard is not attached to the "upper portion" of Girard (*i.e.*, the flaps) so as to pivot relative to the flaps of the upper.

For at least these reasons, it is respectfully submitted that Girard does not anticipate independent claim 14, and thus claims 15-20 depending therefrom. Reconsideration and withdrawal of this rejection is respectfully requested.

#### **IV. CLAIM REJECTIONS UNDER 35 U.S.C. § 103(A)**

##### **A. Rejection Over Aguerre**

Claims 18 and 22 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over the cited portions of Aguerre. This rejection is respectfully traversed for at least the reasons which follow.

Initially, it is noted that the Examiner appears to indicate that former dependent claim 22 related solely to the selection of materials. However, it is noted that original dependent claim 22 recited that the sole and upper portion were formed as a single part from a moldable

foam material. As such, it is submitted that claim 22 related to more than a mere selection of materials, as it specified that the sole and upper portion were formed from a single part. However, claim 22 has been canceled and as such, the rejection is now moot.

Whatever else Aguerre may show, as discussed above, Aguerre does not include a sole and an upper portion formed as a first part molded from a first continuous piece of lofted foam material, a strap attached to an upper portion, or a strap connected to the upper portion so as to pivot relative to the upper portion.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. The teaching or suggestion to make the claimed combination must be found in the prior art, and not be based on applicants' disclosure. See M.P.E.P. §§2143.01 and 2143.03.

In a proper obviousness determination, the changes from the prior art must be evaluated in terms of the whole invention, including whether the prior art provides any teaching or suggestion to one of ordinary skill in the art to make the changes that would produce the claimed invention. See *In re Chu*, 36 U.S.P.Q.2d 1089, 1094 (Fed. Cir. 1995). This includes what could be characterized as simple changes. See, e.g., *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (Although a prior art device could have been turned upside down, that did not make the modification obvious unless the prior art fairly suggested the desirability of turning the device upside down.). Only when the prior art teaches or suggests the claimed invention does the burden fall on the applicant to rebut that *prima facie* case. See *In re Dillon*, 16 U.S.P.Q.2d 1897, 1901 (Fed. Cir. 1990) (in banc), *cert. denied*, 500 U.S. 904 (1991). However, a *prima facie* case of obviousness may be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. See *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

As mentioned above, the present claims require (1) that the sole and the upper portion be formed as a first part molded from a first continuous piece of the lofted foam material, and (2) the strap is attached to the upper portion such that the strap contacts the upper portion

and pivots relative to the upper portion. Even assuming, *arguendo*, that the self-adjusting harness of Aguerre amounts to an upper portion adapted to cover the top of a user's foot, the straps of the harness are independent from the stacked sole layers, and are not formed as part molded from a continuous piece of lofted foam material. Furthermore, the "sole" of Aguerre is comprised of three distinct layers (*i.e.*, the insole, midsole, and outsole), and thus is not formed as a part molded from a continuous piece of lofted foam material. As disclosed, the layers of the stacked sole must be discrete layers to allow for the configuration wherein the self-adjusting harness, the center-toe strap, and the rear strap are anchored between the insole layer and the outsole layer. Moreover, the strap sections crossing over the top of the foot must be independent from the stacked sole layers in order to achieve the intended purpose of a self-adjusting harness. As such, for at least this reason, one of skill in the art would not be lead to modify the teachings of Aguerre so as to arrive at the molded, continuous piece of lofted foam material, as required by the present claims.

In addition, the adjustable heel strap of Aguerre is not attached to the "upper portion" of Aguerre (*i.e.*, the straps adapted to cross over the top of the user's foot). Rather, the adjustable heel strap is connected to the rear buckles of the rear strap. Moreover, the adjustable heel strap is not connected to the rear buckles so as to pivot relative to the straps of the adjustable harness. As discussed above, the sandal of Aguerre provides a self-adjusting harness in combination with the adjustable heel strap. If the adjustable heel strap were to attach directly to the self-adjusting harness, and pivot relative to it, the intended purposes of the self-adjusting harness would not be achieved. As such, for at least this additional reason, one of skill would not be motivated to modify the teachings of Aguerre to arrive at the present invention.

In the absence of a teaching or suggestion to modify the teachings of Aguerre to arrive at the claimed configurations, the cited art does not render obvious each and every limitation of the present claims. For at least these reasons, Applicants traverse, and respectfully request withdrawal of this rejection.

B. Rejection Over Girard

Claims 18, 20, and 22 also stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Girard. This rejection is respectfully traversed for at least the reasons which follow.

Again, whatever else Girard may disclose, it does not teach: (1) a sole and an upper portion formed as a first part molded from a first continuous piece of lofted foam material, or (2) or a strap connected to the upper portion so as to pivot relative to the upper portion. As discussed above, the flaps of the upper as disclosed by Girard are discrete elements and are independent from the sole of the sandal. The flaps must be discrete elements to allow for the disclosed configuration and to achieve the intended purpose of a tightening mechanism which properly distributes the pressures generated by the tightening device. As such, for at least this reason, one of skill in the art would not be lead to modify the teachings of Girard so as to arrive at the molded, continuous piece of lofted foam material, as required by the present claims.

In addition, the rear holding strap of Girard is not attached to the “upper portion” of Girard (*i.e.*, the flaps) so as to pivot relative to the flaps of the upper. There is no discussion or indication in Girard to suggest to one of skill in the art the desirability of a rear holding strap which is attached to the flaps so as to pivot relative to the flaps. Absent such a teaching or suggestion, one of skill in the art would not have been motivated to modify the teachings of Girard so as to arrive at the present invention.

For at least these reasons, Applicants traverse, and respectfully request withdrawal of this rejection.

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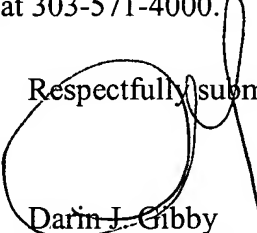
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**CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
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